

**REMARKS**

Claims 1, 4, 6-8 and 10 are pending in this application. By this Amendment, claims 1, 6-8 and 10 are amended. The amendments introduce no new matter. Claims 5 and 9 are canceled without prejudice to, or disclaimer of, the subject matter recited in those claims. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representative by Examiners Chen and Deng in the June 10, 2008 personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

The Office Action objects to claims 1 and 4-10, and rejects claims 7-10 under 35 U.S.C. §112, based on informalities. The claims are amended to obviate these objections and rejections. Reconsideration and withdrawal of the objections and rejections are respectfully requested.

The Office Action rejects claims 1 and 4-6 under 35 U.S.C. §101. This rejection is respectfully traversed.

The Office Action asserts that the rejected claims are directed to software *per se*. However, MPEP §2106.01(I) provides that finding claims directed to software *per se* is proper only when the claimed invention taken as a whole is directed to a mere program listing, *i.e.* to only its description or expression, it is descriptive material *per se* and hence non-statutory. The rejected claims recite more than a mere program listing. For example, at least the display unit that displays a service list, as recited in claim 1, satisfies the requirements of 35 U.S.C. §101.

MPEP §2106.01(I) also provides that a computer program may be part of an otherwise statutory manufacture or machine. In such cases, the claim remains statutory irrespective of the fact that a computer program may be included in the claim. In other words, merely

because aspects of a claim could be embodied by a computer program, does not render the overall claim non-statutory. As such, claim 1 is understood to recite statutory subject matter.

Reconsideration and withdrawal of the rejection are respectfully requested.

The Office Action rejects claims 1 and 4-10 under 35 U.S.C. §102(b) over U.S. Patent Application Publication No. 2002/0052796 to Tadokoro et al. (hereinafter "Tadokoro"). This rejection is respectfully traversed.

Without conceding the interpretation, or application, of the applied reference, and solely to advance prosecution of this application, independent claims 1 and 7 are amended to clarify relevant features. Support for the amendments can be found, for example, on page 18, line 19 - page 19, line 9 of Applicant's disclosure, as filed. The applied reference cannot reasonably be considered to teach such combinations of features for at least the following reasons.

Claim 1 recites, among other features, a service acquisition unit that acquires plural services available to a user by using user information, wherein the user information is updated when at least one of the plural services is selected, and the plural services available to the user being determined by the content of a restriction value table expressing restrictions on execution of services and values of the user information are checked against values of the restriction value table; a cooperation instruction information creation unit that creates the cooperation instruction information by using the plural services acquired by the service acquisition unit; and a display unit that displays a service list, the service list including a list of the plural services available to the user which the user can use at present, wherein each of the plural services performs a specific processing on document data, the service acquisition unit acquires at least one of the plural services available to the user for each of functions constituting a job flow that is created and the cooperation instruction information creation unit provides for selection of at least one of the plural services available to the user.

corresponding to each of the functions, and the plural services available to the user and the user information are updated with each selection. Claim 7 recites similar features. The applied reference does not teach such combinations of features.

Tadokoro does not teach the combinations of the above features at least because the allegedly corresponding features of Tadokoro deal with determining whether a user has access to a particular service, and, if the service providing system does not have the specific service, managing access to another service providing system to provide this specific service to the user (see paragraph [0008]). As discussed in paragraph [0063] of Tadokoro, service information classified by user may be stored in a table denoting services accessible. However, such features do not correspond to at least the user information is updated when at least one of the plural services is selected, or the plural services available to the user and the user information are updated with each selection.

Additionally, the relied-upon Figs 18-20 and 25 of Tadokoro do not apparently teach all of the features regarding the service acquisition unit determines and acquires a service having minimum restrictions for each of the functions constituting the job flow, and the cooperation instruction information creation unit creates the cooperation instruction information by associating the respective plural services acquired by the service acquisition unit with the respective functions constituting the job flow, as recited in claim 6, and similarly recited features of claim 10.

In reviewing the anticipation standard, the Federal Circuit has stated "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375 (Fed. Cir. 2001), *cert. denied*, 122 S. Ct. 1436 (2002) (emphasis added). *See also Sandisk Corp. v. Lexar Media, Inc.*, 91 F. Supp. 2d 1327, 1336 (N.D. Calif. 2000) (stating that "[u]nless all the elements are found in a single piece of prior art in exactly the same situation

and united the same way to perform the identical function, there is no anticipation.") and *Aero Industries Inc. v. John Donovan Enterprises-Florida Inc.*, 53 USPQ2d 1547, 1555 (S.D. Ind. 1999) (stating that "[n]ot only must a prior patent or publication contain all of the claimed elements of the patent claim being challenged, but they 'must be arranged as in the patented device' "). This standard for anticipation is also set forth in MPEP §2131, which states that "the identical invention must be shown in as much detail as is contained in the ... claim."

The above standard is not met by the application of Tadokoro to the pending claims at least because Tadokoro does not teach every feature of the pending claims, arranged as in the claims.

These arguments were discussed during the June 10 personal interview with the Examiners. The Examiners agreed that further review of the rejection would be appropriate upon submission of a formal response. Applicant appreciates this agreement by the Examiners.

For at least the above reasons, the applied reference does not teach the combinations of features positively recited in independent claims 1 and 7, and dependent claims 6 and 10. Additionally, claims 4 and 8 are also not taught by the applied reference for at least the respective dependence of these claims, directly or indirectly, on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 4, 6-8 and 10 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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